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2016 – Study Question (Designs)

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Requirements for protection of designs

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I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Industrial design registration.

3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a) novelty

Yes, Brazilian IP law states that an industrial design is considered to be new when not comprised by the state of the art.

b) non-obviousness

c) inventive step

d) individual character

e) originality

Yes, Brazilian law provides that an industrial design is considered original when it results in a distinctive visual configuration in relation to other prior objects.

f) aesthetic

g) ornamental

Yes, Brazilian IP law determines that an industrial design is considered to be any ornamental plastic form of an object or any ornamental arrangement of lines and colors that may be applied to a product, that provides a new and original visual result in its external configuration, and that may serve as a type for industrial manufacture.

h) other, namely ...

the possibility or serving as a type for industrial manufacture.

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes. Actually, Local law solely dictates that an industrial design is not registrable for the shape of an object that is determined essentially by technical or functional considerations.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

Yes, local law does not provide how to assert the infringement in such cases. Likewise, the Brazilian jurisprudence is very scarce in this regard. Particularly, Brazilian jurisprudence regarding industrial design litigation is not developed and/or clear enough to allow us a precise opinion as to how a design infringement should be evaluated by the Courts. Most cases are decided based on the opinion of a judicial expert chosen by the judge and, unfortunately, many of them have lack consistent knowledge and experience to give a consistent decision on design infringement cases.

g) other, namely ...

II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

b) the requirements for protection of a design

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

There is a need for a regulation and/or guidelines with provisions concerning this aspect.

As mentioned before, Brazilian IP law does not provide clear directives on what can be deemed as falling under the existing prohibition. The adoption of such a directive would be helpful for both examiners and owners of IP rights. In this sense, a harmonized procedure from the Brazilian PTO, established by clear regulations, would facilitate the examination as well as infringement analysis.

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

yes

Please explain:

Due to the absence of directives, on December 07, 2015, the Designs Committee of the Brazilian IP association (local group of AIPPI) submitted a draft of proposal directives which, among other aspects, provides a recommended procedure on how to analyze the functionality aspect of claimed objects. The draft resulted from a joint work of members of the association (attorneys and industry).

The part of the draft related to this matter reads as follows:

*“Firstly, it is noteworthy that the shape of the object of an industrial design registration usually takes into account "technical or functional considerations" related to the use of the product. For example, a chair will generally have one or more legs, seat, back and possibly arms. This fact alone is not an impediment to the granting of registration. The law excludes from protection those products which are **essentially** determined by technical or functional considerations, i.e., in general, those products whose shape cannot be other than that which meet certain technical specifications or that is required to perform certain functions. Although part of the product has a shape that is essentially determined by technical or functional considerations (e.g. .: the terminal of an electrical plug), it must be ascertained whether, as regards the general appearance of the product, there was a creation which configures, in terms of art. 95, an “ornamental plastic form”, or even if the object is characterized by an “ornamental arrangement of lines and colors” which is not essentially determined (a) by technical or functional considerations.*



Thus, the fact that a claimed product is intended for a technical application does not prevent it to be properly protected by the industrial design registration.

The analysis to be made in this case is to determine whether a particular industrial design, if

registered, would have the ability to prevent the activities of third parties in certain technological field. Possibly, this situation will occur only in those cases where a new technology or functionality was created, invented or designed by the author of the design. Still, it would be necessary to prove that all the elements of the submitted shape are decisive for the product to perform the function for which it was designed not admitting other shapes that meet the same technical functionality.”

III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

Yes to all.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

no

Please explain:

13) If so, what should that right be called?

Not applicable.

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

b) non-obviousness

c) inventive step

d) individual character

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

Yes.

b) whether each portion of the overall appearance is dictated solely by its technical function

c) the availability of alternative appearances that can obtain the same functional result

This aspect shall be one of the possible tests to be applied, so as to assert functionality.

d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

e) other, namely ...

17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

no

Please explain:

18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

b) the availability of alternative appearances for the portion to obtain the same functional result

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

d) other, namely ...

19) What should the effect be on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

b) any portions deemed functional will not be taken into account when assessing validity

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

Yes.

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

Yes.

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

f) the Group's current law is unsettled

Brazilian IP Law does not expressly address on how to assess the scope of protection of a design with one or more functional portions.

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

21) If yes, why?

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

Summary